

REMARKS/ARGUMENTS

In the Restriction Requirement dated April 9, 2008, the Examiner delineated the following inventions as being patentably distinct.

Group I Claim(s) 1-8, drawn to a method of measuring transcriptional activity in cells transplanted into a non-human animal model.

Group II Claim(s) 15-23 drawn to a method of measuring the number of transplanted cells in a non-human animal model.

Group III Claim(s) 31-39, drawn to a method of measuring tumor volume in a non-human animal model.

Accordingly Applicants elect Group I (Claims 1-8 plus newly amended Claims 9-12) with traverse.

Regarding the election of a single species, Applicants elect without traverse SEQ ID NO: 1.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinction, rather the Office has merely stated conclusions. Accordingly the Office has failed to meet the burden necessary to sustain the restriction requirement, and the Office has not shown that a burden exists in searching all of the claims.

Further, M.P.E.P. § 803 states as follows:

“If a search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

In chemical cases a specified group of materials which do not necessarily belong to an otherwise clear can be claimed together employing “Markush” practice, which sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush grouping need only possess at least one property in common which is mainly responsible for the function of the claimed relationship. The instant application is directed to measuring the transcriptional activity of cell transplanted into non-human animals and using it as a screening method to specifically select compounds that affect the transcriptional activity and measuring the secretory protein. The same utility in a generic sense suffices.

The Examiner has failed to consider that the claims in each group are considered related inventions under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT Rule 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(b) provides in relevant parts that “a national stage application containing claims to different categories of invention will be considered to have unity of invention.” As the Office has not sufficiently shown any evidence that a restriction should now be required when the International Preliminary Report did not, restriction is believed to be improper.

Applicants make no statement regarding the patentable distinctness of the species, but note that for the restriction to be proper, there must be patentable differences between the species as claimed. M.P.E.P. § 808.01(a). Applicants election of a single species is for examination purpose only.

Finally, with respect to the elected species, Applicants respectfully submit that should the elected species be found allowable the Office should expand its search to the non-elected species.

Applicants respectfully submit that the above identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.


Respectfully submitted,

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